

REMARKS

By the above amendment, claims 3, 4, 6, 7 and 11 - 17 have been canceled without prejudice or disclaimer of the subject matter thereof, and the remaining claims have been amended to clarify and recite features in a manner which is considered to be in compliance with 35 USC 112.

With regard to the Examiner's indication that the listing of references in the specification is not a proper information disclosure statement under 37 CFR 1.98(b), applicants note that not only does the specification include a listing of documents, but a separate paper entitled "Information Under 37 CFR 1.56(a)" was submitted, together with copies of the indicated documents and an English language abstract. Such documents were submitted pursuant to 37 CFR 1.56(a), and whether or not the Examiner desires to consider the same, the Examiner has been put on notice with regard to such documents, and the duty of disclosure under 37 CFR 1.56(a) with respect to such documents has been satisfied.

As to the rejection of claims 1, 5, 8 and 12 under 35 USC 112, second paragraph as being indefinite, by the present amendment, claim 12 has been canceled and claims 1, 5 and 8 have been amended in a manner which is considered to overcome the various points raised by the Examiner. Thus, applicants submit that independent claim 1, as amended and the dependent claims thereof should now be considered to be in compliance with 35 USC 112, second paragraph.

Turning to claim 1, applicants note that claim 1 has been amended to recite the features of an electronic device comprising a main body and a fuel cell, as illustrated in Fig. 1 of the drawings of this application, for example. More particularly, as described in the paragraph bridging pages 4 - 6 of the specification, Fig. 1 illustrates an electronic device in the form of a so-called notebook computer which

comprises a main body having semiconductor circuits for executing arithmetic operations and a cover member in the form of a display section 2 which covers the main body. A fuel cell is composed mainly of a power generator panel 1 and a fuel tank 3. As more clearly illustrated in Figs. 2 and 3 of the drawings of this application, the fuel cell has a first surface 1a for taking in air and a second surface 1b for taking in air which is formed in an opposite side to the first surface, and when the fuel cell stops supplying the power to the main body, as illustrated in Fig. 2, the first surface 1a is in one state facing the main body, and when the fuel cell supplies power to the main body, as illustrated in Fig. 3, the first surface 1a moves to a second state remote from the main body as compared with the first state, which is illustrated in Fig. 2. That is, as described at page 7, line 19 to page 8, line 1 of the specification, the distance between the power generation panel and the electronic device differs between the power supply mode and the power stop mode, wherein the space between the power generation panel 1 and the information electronic device 4 becomes wide or narrow. Applicants submit that such features are clearly described in the specification of this application and set forth in independent claim 1 and the dependent claims of this application, and that such features are not disclosed or taught in the cited art as will become clear from the following discussion.

The rejection of claims 1 - 3, 5 and 12 - 15 under 35 USC 102(a) as being anticipated by Nakakubo (WO 03/049223) as evidenced by the use of translation of Nakakubo (US 2005/008918 A1); the rejection of claims 4, 6 - 7, 9 - 10 and 17 under 35 USC 103(a) as being unpatentable over Nakakubo et al (WO 03/049223) as evidenced by the use of translation of Nakakubo et al (US 2005/008918 A1) in view of Hayashi et al (US 2002/0055029 A1); the rejection of claim 11 under 35 USC 103(a) as being unpatentable over Nakakubo et al (WO 03/049223) as evidenced by

the use of translation of Nakakubo et al (US 2005/0008918 A1) in view of Burokas et al 6,954,852 B2); the rejection of claim 16 under 35 USC 103(a) as being unpatentable over Nakakubo et al (WO 03/049223) as evidenced by the use of translation of Nakakubo et al (US 2005/0008918 A1) in view of Gomez (US 2004/0096718 A1); and the rejection of claims 1 - 2, 4 - 7, 9 - 10, 12 - 14 and 17 under 35 USC 103(a) as being unpatentable over Hayashi et al (US 2002/0055029 A1); such rejections are traversed insofar as they are applicable to the present claims and reconsideration and withdrawal of the rejections are respectfully requested.

As to the requirements to support a rejection under 35 USC 102, reference is made to the decision of In re Robertson, 49 USPQ 2d 1949 (Fed. Cir. 1999), wherein the court pointed out that anticipation under 35 U.S.C. §102 requires that each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. As noted by the court, if the prior art reference does not expressly set forth a particular element of the claim, that reference still may anticipate if the element is "inherent" in its disclosure. To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." Moreover, the court pointed out that inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.

With regard to the requirements to support a rejection under 35 USC 103, reference is made to the decision of In re Fine, 5 USPQ 2d 1596 (Fed. Cir. 1988), wherein the court pointed out that the PTO has the burden under '103 to establish a

prima facie case of obviousness and can satisfy this burden only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references. As noted by the court, whether a particular combination might be "obvious to try" is not a legitimate test of patentability and obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. As further noted by the court, one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

Furthermore, such requirements have been clarified in the decision of In re Lee, 61 USPQ 2d 1430 (Fed. Cir. 2002) wherein the court in reversing an obviousness rejection indicated that deficiencies of the cited references cannot be remedied with conclusions about what is "basic knowledge" or "common knowledge".

The court pointed out:

The Examiner's conclusory statements that "the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software" and that "another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial" do not adequately address the issue of motivation to combine. This factual question of motivation is immaterial to patentability, and could not be resolved on subjected belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher."... Thus, the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion. (emphasis added)

Turning first to the utilization of Nakakubo et al (WO 03/0049223), applicants submit that this document is not properly utilizable under 35 USC 102 or 35 USC 103, in that the 371(c) date or US filing date is June 4, 2004, noting that the PCT application was not filed or published in the English language. That is, in accordance with the requirements of MPEP §201.15, submitted herewith is a verified English translation of the priority document of this application, i.e., Japanese Patent Application No. 2002/289363, filed October 2, 2002, for which priority has been claimed in this application and the certified copy has been submitted on July 21, 2003, which acknowledgement and receipt of the certified copy has been acknowledged by the Examiner in the Office Action dated February 6, 2006. As is apparent the date of Nakakubo et al is subsequent to the priority date of this application. Thus, applicants submit that all rejections in which Nakakubo (WO 03/049223) is utilized as a primary reference under 35 USC 102 and or 35 USC 103 should be overcome such that all of these rejections necessarily fall and a discussion of the secondary references utilized in combination with Nakakubo is unnecessary.

Applicants note that the Examiner has rejected claims under 35 USC 103(a) as being unpatentable over Hayashi et al (US 2002/0055029 A1), wherein in attempting to apply Hayashi et al to the claimed invention, the Examiner states:

Hayashi et al does not expressly disclose the electronic device using a fuel cell as having a power generator panel or fuel assembly panel taking in air through at least two wall surfaces, one wall surface and the other wall surface being opposite to one another and the distance between said power generator panel and said electronic device differing between the power supply state and the power stop state of the fuel cell. (emphasis added).

Applicants note that the Examiner's recognized deficiency of Hayashi et al represents a deficiency with respect to the features as now recited in independent claim 1 and the dependent claims of this application.

The Examiner contends:

However, it is obvious to one of ordinary skill in the art to have more than one air vent opening for air to enter the fuel cell assembly panel so as to be able to provide air to a larger surface area in a shorter amount of time and increase the electrical output of the system. It is also well known to one of ordinary skill in the art that a fuel cell heats up in the power supply state, it will expand and fill in more space within an enclosure or between the power generator panel and the electronic device than it will when it is cooler cooling down in the power stop state. (emphasis added).

Applicants submit that the Examiner's position represents the utilization of the principle of "obvious to try" which is not the standard of 35 USC 103 and further represents a hindsight reconstruction attempt in complete disregard of the disclosure of Hayashi et al. See In re Fine, supra.

Irrespective of the contentions of the Examiner, in Hayashi et al, there is disclosed a fuel cell taking in air from one surface thereof via the air inlet portion 41A provided on a bottom surface of a display of a note-type personal computer in which the surface of the fuel cell taking in air and the bottom surface of the display face one another. The design in Hayashi et al is such that a sufficient space for taking in air in advance is provided between the bottom surface of the display and the surface of the fuel cell taking in the air. The fuel cell is fixedly provided relative to the display, which results in an increase in thickness and overall size of the note-type personal computer including the fuel cell. Thus, Hayashi et al merely discloses that the fuel cell is fixedly provided on the note-type personal computer, and in addition to failing to disclose or teach a fuel cell having a first surface for taking in air and a second surface for taking in air and formed on an opposite side to the first surface, Hayashi et al fails to disclose or teach, as now recited in claim 1, that when the fuel cell stops supplying power to the main body, the first surface is in one state facing the main body, and wherein when the fuel cell supplies power to the main body, the first

surface moves to a second state remote from the main body as compared with the first state. That is, in the present invention, when the electronic device is supplied with power from the fuel cell to the electronic device, the fuel cell is provided so as to be spaced apart from the electronic device so that air may be easily taken in and a first surface of the fuel cell. When the supply of power stopped, a distance between the fuel cell and the electronic device is reduced, which permits decrease thickness and overall size of the electronic device including the fuel cell and enhancement of the portable hand-carrying characteristic of such electronic device. In Hayashi et al, it is apparent that the fuel cell is fixedly provided on the note-type personal computer, and utilizing the Examiner's contention that the fuel cell expands in the power state such would result in a feature that a surface facing the electronic device is closer to the electronic device in the power or heated state than in the non-powered state, which is contrary to the recited features of claim 1. As to the features of the dependent claims, applicants submit that Hayashi et al also fails to disclose or teach the features recites in the dependent claims in the sense of 35 USC 103 such that applicants submit that claim 1 and the dependent claims patentably distinguish over Hayashi et al in the sense of 35 USC 103.

As to the utilization of Burokas et al and Gomez, irrespective of the Examiner's contentions, this cited art fails to overcome the deficiencies, pointed out above, with respect to the recited features of claim 1 and the dependent claims of this application. Accordingly, applicants submit that all claims patentably distinguish over this cited art in the sense of 35 USC 103 and should be considered allowable thereover.

In view of the above amendments and remarks and the submission of the verified English translation, applicants submit that all rejections should be overcome


and applicants submit that all claims should now be in condition for allowance.

Accordingly, issuance of an action of favorable nature is courteously solicited.

To the extent necessary, applicants petition for an extension of time under 37 CFR 1.136. Please charge any shortage in the fees due in connection with the filing of this paper, including extension of time fees, to the deposit account of Antonelli, Terry, Stout & Kraus, LLP, Deposit Account No. 01-2135 (Case: 500.42921X00), and please credit any excess fees to such deposit account.

Respectfully submitted,

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